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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/841,264 | 04/24/2001 | Ranjani V. Parthasarathy | 56286USA4A.003 | 5359 |

32692 7590 07/28/2003

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EXAMINER

NAFF, DAVID M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1651

DATE MAILED: 07/28/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/841264

Applicant(s)

Parthasarathy et al

Examiner

Kraft

Group Art Unit

1451

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 6/30/03
- ☐ This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-50 is/are pending in the application.
- ☐ Of the above claim(s) is/are withdrawn from consideration.
- ☐ Claim(s) is/are allowed.
- ☐ Claim(s) is/are rejected.
- ☐ Claim(s) is/are objected to.
- ☒ Claim(s) 1-50 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

In view of the amendment of 6/30/03 containing a copy of an Information Disclosure Statement and preliminary amendment filed 3/7/02 that did not reach the application file, and the preliminary amendment adding figures 2-4, amending the specification to provide additional description and adding claims 46-50, the final rejection of 4/8/03 is withdrawn and prosecution is reopened.

The amendment of 6/30/03 and preliminary amendment of 3/7/03 have been entered.

The preliminary amendment did not contain a copy of added Figures 2-4.

Claims in the application are 1-50.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-24, drawn to a composition containing an enzyme, surfactant and dye, wherein the dye inactivates the enzyme and the surfactant inhibits the inactivation, and methods of stabilizing an enzyme in a fluid sample by combining the surfactant with the enzyme and dye, classified in class 435, subclass 188.
- II. Claims 25-45, drawn to methods of conducting a thermal process, conducting a thermal cycling process and denaturing hydrogen-bonded molecules by heating to raise the temperature, classified in class 435, subclass 41.

III. Claims 46 and 47, drawn to a device having a valve between selected pairs of a plurality of process chambers for use in thermal processing, classified in class 435, subclass 289.1.

IV. Claim 48, drawn to a method of conducting a thermal cycling process using a device having a plurality of process chambers, and rotating the device while delivering electromagnetic energy to raise the temperature of a sample mixture in the chambers, classified in class 435, subclass 173.1.

V. Claims 49 and 50, drawn to a method of processing a sample material using a device containing a plurality of process chamber arrays, each array having a loading chamber, first process chamber and second process chamber, moving sample from the loading chamber to the first process chamber and from the first to the second process chamber by rotating the device, and controlling temperature of sample in the first and second chambers by rotating the device while applying electromagnetic energy, classified in class 435, subclass 4.

The inventions are distinct, each from the other because:

The composition containing an enzyme and method of stabilizing an enzyme of I can be used without conducting a thermal process, thermal cycling and denaturing hydrogen-bonded molecules as required by II, without using a device as required by III, without conducting thermal cycling with a device as required by IV, and without conducting processing of a sample material with a device as required by V. The composition and enzyme stabilizing method of I can be used for stabilizing an enzyme for

its conventional use where there is no heating to conduct a thermal process, a thermal cycling process or to denature hydrogen-bonded molecules as in II, and without using devices as required by III, and the methods of IV and V. Conducting a thermal process, thermal cycling and
5 denaturing hydrogen-bonded molecules as in II can be carried out without stabilizing an enzyme as required in I and without using the devices as required by III, IV and V. The device of III can be used for a method other than required by IV and V since methods of IV and V require devices different than required by III. Methods IV and V can be performed
10 without performing methods in I and II since methods of I and II do not require devices as required by IV and V. Methods IV and V require different steps and different devices, and each can be carried out without performing the other.

Because these inventions are distinct for the reasons given above
15 and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even
20 though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application.

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Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David M. Naff whose telephone
5 number is (703) 308-0520. The examiner can normally be reached on Monday-Thursday and every other Friday from about 8:30 AM to about 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, a message can be left on voice mail.

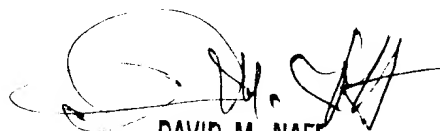
10 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Wityshyn, can be reached at telephone number (703) 308-4743.

The fax phone number is (703) 872-9306 before final rejection or (703) 872-9307 after final rejection.

15 Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

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DMN
7/24/03


DAVID M. NAFF
PRIMARY EXAMINER
ART UNIT 1651